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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,879	01/31/2002	Mark Ian Cockett	AHP 98089 D1	4886
25291	7590	11/18/2003	EXAMINER	
WYETH PATENT LAW GROUP FIVE GIRALDA FARMS MADISON, NJ 07940			SHUKLA, RAM R	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/062,879		COCKETT ET AL.	
	Examiner		Art Unit	
	Ram R. Shukla		1632	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 11, drawn to a polynucleotide composition, a host cell comprising the composition and a method of producing polypeptide encoded by the polypeptide, classified in class 536, subclass 23.1.
- II. Claims 8-10, drawn to a Kv4.3 polypeptide, classified in class 530, subclass 350.
- III. Claim 12, drawn to an antibody, classified in class 530, subclass 387.1.
- IV. Claim 13, drawn to a method of diagnosing a disease by measuring presence of protein, classified in class 436, subclass 501.
- V. Claim 14, drawn to a method of diagnosing a disease by measuring the presence of a nucleic acid, classified in class 435, subclass 6.
- VI. Claim 15, drawn to a method of identifying compounds that interact with a polypeptide, classified in class 435, subclass 4.
- VII. Claim 16, drawn to a transgenic animal, classified in class 800, subclass 8.

3. The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I-III are drawn to compositions that have different physical and chemical structure, different sequence composition and structure, different function and different utilities. Therefore, the search for one composition will not be coextensive for another composition. For example, search for a nucleic acid will not yield art related to a protein or antibody.

The methods of the groups IV-VI are patentably distinct each from the other because they are drawn to methods that have distinct steps that cannot be

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interchanged. For example, the steps of a determining a protein in a sample and the reactants used in such a method cannot be used in the method for determining a nucleic acid in a sample or a method of diagnosis or a method of screening for compounds.

The methods of each of the groups IV-VI are patentably distinct from the compositions of the groups I-III because the methods of the groups IV-VI can not be used for making the compositions of the groups I-III. Additionally, the compositions of the groups I-III cannot be used in different methods of groups IV-VI. It is noted that while the nucleic acid of the group I can be used in practicing the method of group V, it can be used in several patentably distinct methods, such as the method of group V or the animal of group VII. Likewise the composition of group II can be used in multiple patentably distinct methods such as those of groups IV and VI.

The transgenic animal of group VII is patentably distinct from the inventions of the groups I-VI because it has structure, function and utilities that are not shared by any of the groups I-VI. For example, the methods of the groups IV-VI cannot be used for making the animals of group VII. Likewise the compositions of the groups II and III cannot be used for making the animals of groups VII.

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be

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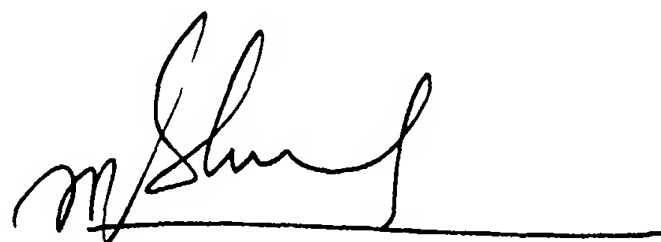
accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for TC 1600 is (703) 703-872-9306. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the William Phillips whose telephone number is (703) 305-3413.

Ram R. Shukla, Ph.D.

Primary Examiner

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A handwritten signature in black ink, appearing to read 'R. Shukla', written over a horizontal line.

RAM R. SHUKLA, PH.D.
PRIMARY EXAMINER